

REMARKS

In the Office Action mailed June 16, 2010, the Examiner:

- (1) objected to claim 30 due to alleged informalities;
- (2) provisionally rejected claims 30-55 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 30-55 of copending Application No. 10/573,031;
- (3) rejected claims 30-52 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- (4) rejected claim 55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0130937 to Reynold (“Reynold”);
- (5) rejected claims 30, 31, and 36-55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,254,558 to Hinkle et al. (“Hinkle”)¹ in view of U.S. Patent No. 6,989,820 to Baker et al. (“Baker”) and European Patent No. 1,164,519 to Ahmed (“Ahmed”); and
- (6) rejected claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Hinkle, Baker, Ahmed, and further in view of U.S. Patent No. 6,718,535 to Underwood (“Underwood”).

By this Amendment, claims 30-33, 35, 36, 40-45, 47-49, 51, 54, and 55 are amended. Support for the amendments may be found in the Specification at, for example, page 24, lines 11-31. Claims 30-55 are pending and under current examination.

I. Claim Objection

Applicant respectfully traverses the objection of claim 30. However, solely to advance prosecution, claim 30 has been amended for further clarity. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection.

II. Provisional Non-statutory Double Patenting

¹ In the Office Action, the Examiner listed U.S. Patent No. 7,254,288 which is a patent titled “Corner Cube Depolarizer” to Kalibjian. In this Amendment, Applicant assumes that the Examiner meant to cite U.S. Patent No. 7,254,558, which is listed in the PTO-892 form, to Hinkle et al.

Applicant respectfully traverses the provisional double-patenting rejections and requests that the rejections be held in abeyance. Application No. 10/573,024 (“the ‘024 application”) and Application No. 10/573,031 (“the ‘031 application”) are currently pending and, thus, no double patenting circumstances can arise until a patent is granted. Since no patent has apparently issued from the ‘024 application or the ‘031 application, Applicant respectfully requests that the provisional rejections be held in abeyance and any resolution in the form of a Terminal Disclaimer or otherwise be deferred.

III. 35 U.S.C. § 101 Rejection of Claims 30-52

Applicant respectfully traverses the rejection of claims 30-52 under 35 U.S.C. § 101. The *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*, Docket No. PTO-P-2010-0067, as published by the U.S.P.T.O. in the Federal Register on July 27, 2010, “provides factors to consider in determining subject matter eligibility of method claims,” and states that the machine-or-transformation test “is not the sole test for deciding whether an invention is a patent-eligible ‘process.’” Quoting *Bilski v. Kappos*, 561 U.S. ___, Slip Op. at 8 (2010).

Nevertheless, independent claim 30 has been amended in a manner to overcome the rejection. Claims 31-52 were rejected as being dependent on allegedly non-statutory independent claim 30. Because claim 30 is drawn to statutory subject matter, remaining claims 31-52 also recite statutory subject matter. Applicant respectfully requests that the rejection of claims 30-52 under 35 U.S.C. § 101 be withdrawn.

IV. 35 U.S.C. § 103 Rejection of Claim 55

Applicant respectfully traverses the rejection of claim 55 under 35 U.S.C. §103(a) as obvious over Reynolds.

The Office Action alleged that because “the instructions themselves are claimed, rather than the method steps performed when the code stored on the computer readable medium is executed by a processor,” “these limitations are directed towards nonfunctional descriptive material.” Office Action at p. 6. Accordingly, the Office Action did not consider the limitations including “selecting,” “assigning,” and “using.” Applicant disagrees with these allegations. However, solely to advance prosecution, claim 55 has been amended for further clarity, which recites “[a] non-transitory computer-readable storage device storing a computer program which, when executed by a processor, causes the processor to perform a method.” However, a *prima facie* case of obviousness has not been established with respect to amended claim 55.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious...[R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquires...[include determining the scope and content of the prior art]...[a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent amended claim 55 recites, *inter alia*, “selecting, from a plurality of invoices, a first set of invoices which are due within a specified time period and which have a balance larger than a first threshold value; selecting, from the first set of invoices, a second set of invoices for which a full payment of the respective balance has not been received; assigning a first state to invoices in the second set of invoices; and using the first state to control processing of the invoices.” Reynold, cited merely for its alleged teaching of “a computer readable medium,” does not teach, suggest, or render obvious at least these elements of independent claim 1.

Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and independent claim 55. Therefore, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Accordingly, the Office Action has not met the burden of establishing a *prima facie* case of obviousness of claim 55, and thus, the rejection of this claim under 35 U.S.C. § 103(a) must be withdrawn.

IV. 35 U.S.C. § 103 Rejection of Claims 30-31 and 36-55

Applicant respectfully traverses the rejection of claims 30-31 and 36-55 under 35 U.S.C. §103(a) as obvious over either Hinkle alone or in view of Baker and Ahmed. A *prima facie* case of obviousness has not been established with respect to these claims.

Claim 30 recites, in part, “selecting, by the computer, from the first set of invoices, a second set of invoices for which a full payment of the respective balance has not been received;” and “assigning, by the computer, a first state to invoices in the second set of invoices.” The cited references do not teach, suggest, or render obvious at least these elements of independent claim 30.

Hinkle discloses “a system...configured to generate a collection priority value from information stored on the system and queue the accounts for collection action based on the priority value and user entered filtering criteria.” Hinkle, abstract. In particular, Hinkle discloses that “[i]f the balance exceeds 114 a preset level, system 10 then queries 116 whether the balance has been due for a time within certain preset limits.” Hinkle, col. 4, ll. 45-47. “If the answer to query 116 is affirmative, and a specified form letter has not been sent previously, system 10 then sends 118 the specified form letter.” Hinkle, col. 4, ll. 49-52. Based on these disclosures, the Examiner alleged that “Hinkle discloses comprising: selecting, from a plurality of invoices, such invoices which are due and the balance of which is larger than a first threshold value.” Office Action, p. 6. However, even assuming this allegation solely for the sake of arguments, Hinkle does not teach or suggest “selecting, by the computer, from the first set of invoices, a second set of invoices for which a full payment of the respective balance has not been received,” as recited by claim 30. Indeed, Hinkle does not perform any further query if the balance exceeds the preset value. Instead, Hinkle only “queries 120 whether the item is coded 1...[which] include those with codes CM, UP, PA, and RC,” “[i]f the balance does not exceed the preset value in 114.” Hinkle, col. 4, ll. 52-56 (emphasis added).

Similarly, because Hinkle does not teach or suggest Applicant’s claimed “selecting...a second set of invoices,” Hinkle must also fail to teach or suggest “assigning, by the computer, a first state to invoices in the second set of invoices,” as recited by amended claim 30. Indeed, the Examiner also conceded that “Hinkle fails to disclose” limitations including “assigning a first state to said selected invoices.” Office Action, p. 6.

Baker and Ahmed, alone or in combination, do not cure the deficiencies of Hinkle. Baker discloses “[a]n automated administration system for providing state-based control of soft-labeled keys (SLKs) in a wireless terminal or other type of communication system terminal.” Baker, abstract. Baker has nothing to do with “processing invoices,” and thus, does not teach or suggest “selecting, from the first set of invoices, by the computer, a second set of invoices to which a full payment of the respective balance has not been received,” as recited by claim 30. Furthermore, the Examiner appeared to interpret Baker’s “state” as corresponding to the claimed “first state.” Office Action, pp. 6-7. This is not correct.

According to Baker, a “state represents those events that are legitimate for the user.” Baker, col. 5, ll. 50-52. Therefore, Baker also fails to teach or suggest “assigning, by the computer, a first state to invoices in the second set of invoices,” as recited by amended claim 30.

Ahmed, cited merely for its alleged teaching of “a preselectable time or date,” see Office Action, p. 7, does not teach or suggest either the “selecting...a second set of invoices” element or the “assigning” element.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and amended independent claim 30. Consequently, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Accordingly, the Final Office Action has not met the burden of establishing a *prima facie* case of obviousness of claim 30, and thus, the rejection of this claim under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 54 and 55, while each of a different scope, include elements similar to those discussed above with respect to claim 30 and are allowable for reasons at least similar to those presented above with respect to claim 30. Accordingly, a *prima facie* case of obviousness has not been established for independent claims 54 and 55 for at least reasons similar to those discussed above. Therefore, the Examiner should also withdraw the rejection of claims 54 and 55 under 35 U.S.C. § 103(a) based on Hinkle, Baker, and Ahmed.

Claims 31 and 36-53 depend from independent claim 30. Therefore, a *prima facie* case of obviousness has not been established for claims 31 and 36-54 at least due to their dependence and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

V. 35 U.S.C. § 103 Rejection of Claims 32-35

Applicant further traverses the rejection of claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Hinkle, Baker, Ahmed, and Underwood. Underwood, cited by the Office Action merely for the alleged teaching of “invoices of special importance,” does not cure the deficiencies of Hinkle, Baker, and Ahmed. That is, Hinkle, Baker, Ahmed, and Underwood, taken alone or in combination, do not teach or suggest the elements of claim 30. Therefore, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and amended independent claim 30. Thus, no *prima facie* case of obviousness has been established with respect to claims 32-35 at least because of their dependency from claim 30. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of claim 32-35 under 35 U.S.C. § 103(a).

VI. CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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